

HINSHAW

& CULBERTSON LLP

TTAB

July 27, 2005

VIA EXPRESS MAIL

U.S. Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

ATTORNEYS AT LAW

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Re: Notice of Opposition regarding "HWA plus Design" (Opposition No. 91165596) (Serial No. 76545073)

Dear Sir or Madame:

Enclosed for filing with the Trademark Trial and Appeal Board are copies of the following documents:

1. Applicant's Answer and Affirmative Defenses to Notice of Opposition regarding the "HWA plus Design" mark (in duplicate); and
2. Certificate of Mailing.

If a filing fee is required, please debit our Deposit Account No. 503165 accordingly. Should you have any questions or concerns regarding this matter, please feel free to contact me.

Very truly yours,

HINSHAW & CULBERTSON LLP



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07-27-2005

U.S. Patent & TMO/TM Mail Rcpt Dt. #11

KAM:kam

Encl.

cc: James M. Gibson (w/encl.)
Fitzpatrick, Cella, Harper & Scinto
30 Rockefeller Plaza
New York, New York 10112-3800
(Attorney for Opposer)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

THE HEISMAN TROPHY TRUST,

Opposer,

vs.

HEISMAN WINNERS ASSOCIATION, LLC

Applicant.

Opposition No.: 91165596

Serial No.: 76/545,073



07-27-2005

U.S. Patent & TMO/TM Mail Rpt Dt. #11

**APPLICANT'S ANSWER AND AFFIRMATIVE DEFENSES TO THE NOTICE OF
OPPOSITION**

In response to the Notice of Opposition issued by the Board on June 20, 2005, the Applicant, HEISMAN WINNERS ASSOCIATION, LLC, answers the Opposition identified above as follows:

1. Opposer is a trust which was established under the laws of the State of New York for the purpose of promoting collegiate and other non-professional athletics and maintaining the value and integrity of the Heisman Trophy, including its intellectual property rights. Specifically, the Heisman Award and its indicia are familiar to even the most casual sports enthusiasts due to the Trust's efforts in promoting high school and college football, winners of the Heisman Trophy, and football excellence in general. The Trust's efforts culminate every year with the nationally televised Heisman Award ceremony presenting the Heisman Trophy to the outstanding college football player of the year. These outstanding athletes and the game of football have been promoted under the Heisman Trophy or other Heisman indicia and trademarks for about 70 years.

ANSWER: The Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments set forth in paragraph 1, and on that basis denies each and every such averment.

2. The actual trophy which is awarded to Heisman winners is a distinctive statuette mounted on a base, depicting a football player in a particular pose (the "Heisman Trophy Pose") which has remained essentially the same for decades.

ANSWER: The Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments set forth in paragraph 2, and on that basis denies each and every such averment.

3. Opposer is the owner by assignment of U.S. Registration No. 936,852 for the design mark showing the Heisman Trophy, for "promoting interest, excellence and sportsmanship in intercollegiate football through the medium of an annual award" in International Class 41. This registration is valid and incontestible. Opposer, itself and through its predecessors, began use of this mark at least as early as December 16, 1936, and has used it exclusively and continuously from that date to the present. The Trust also owns several other federal registrations and applications for marks using the word "Heisman" in connection with its Heisman Award enterprise, including applications for marks for use on or in connection with clothing. Copies of printouts from the U.S. Patent and Trademark Office relating to these registrations are attached hereto as Exhibit A (collectively the "Heisman Marks").

ANSWER: Applicant admits only that Exhibit A contains certain printouts from the U.S. Patent and Trademark Office. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining averments of paragraph 3, and on that basis denies each and every remaining averment of paragraph 3.

4. Throughout the years, the Trust has, itself and through its predecessors, licensed numerous clothing manufacturers to make, sell, and distribute throughout the United States clothing items bearing the image of the football player in the Heisman Trophy Pose and/or using the Heisman Marks. Among many other clothing items, articles bearing the Heisman Marks

have included jerseys, jackets, shirts, sweatshirts, t-shirts, hats, polo shirts, and sweatshirts. The Heisman Marks have also been used in connection with the sale of and/or promotion of sports memorabilia such as football helmets, footballs, and other types of memorabilia virtually identical to the goods listed in the '073 application. The Trust owns trademark rights in its Heisman Marks for such goods at common law. Over time these marks have come to signify the Trust and the prestige and high level of excellence embodied in the Heisman Award.

ANSWER: The Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments set forth in paragraph 4, and on that basis denies each and every such averment.

5. On September 16, 2003 Applicant filed the '073 Application seeking registration for its proposed "HWA and design" mark for "clothing, namely jerseys and hats in International Class 25, and "sports memorabilia, namely resin figures, bobble heads, and collectible football helmets" in Class 28. The mark consists of the letters "HWA" which, upon information and belief, is an acronym for "Heisman Winners Association," and a football player carrying a football. The player's pose in the proposed mark is confusingly similar to the Heisman Trophy Pose, as it has been used for years on the Heisman Trophy and in connection with Opposer's or its predecessors' activities in connection with the Heisman Award.

In addition, the letters "HWA" which, upon information and belief, mean "Heisman Winners Association," are confusingly similar to the Heisman Marks and consumers hearing or seeing the words "Heisman Winners Association" are likely to believe that Applicant's goods emanate from the Opposer or that Opposer sponsors or endorses Applicant's goods, when such is not the case.

ANSWER: Applicant admits only that on or about September 16, 2003, it filed a trademark application with the U.S. Patent and Trademark Office. Said application speaks for itself and, therefore Applicant denies each and every averment and legal conclusion inconsistent therewith. Applicant

denies each and every remaining averments and legal conclusion contained in paragraph 5.

6. Opposer, itself and through its predecessors and since long prior to the filing date of the '073 Application, has advertised, promoted, sold and distributed throughout the United States in interstate commerce goods bearing the Heisman Marks. As a result, the aforementioned marks have become identified in the minds of the public and trade with a single source: Opposer.

ANSWER: The Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments set forth in paragraph 6, and on that basis denies each and every such averment.

7. Applicant's goods are identical to some of the goods which have featured Opposer's Heisman Marks, namely football helmets, footballs, jerseys and hats among others. Upon information and belief, Applicant's proposed goods would enter the stream of commerce and be sold in the same or similar channels of trade and would be marketed to the same or a similar class of consumers that are and have been the target of Opposer's own promotion and use of the Heisman Marks.

ANSWER: The Applicant denies each and every averment and legal conclusion set forth in paragraph 7.

8. By reason of the substantial similarity between Opposer's Heisman Marks and the mark shown in the '073 Application, and the fact that the goods and channels of trade are believed to be virtually identical, Applicant is not entitled to registration of the proposed trademark in association with the goods recited in the '073 Application on the grounds that such registration is likely to cause confusion with Opposer's Heisman Marks.

ANSWER: The Applicant denies each and every averment and legal conclusion set forth in paragraph 8.

9. The consuming public, upon seeing Applicant's proposed mark in association with its goods, is likely to believe that the goods are made, endorsed or sponsored by Opposer, or

that there is a trade connection or affiliation between Opposer and its goods, on the one hand, and Applicant and its goods, on the other.

ANSWER: The Applicant denies each and every averment and legal conclusion set forth in paragraph 9.

10. Opposer will be damaged by the confusion which will result to the public if Applicant is permitted to obtain a registration for the proposed trademark. Any faults or defects which might be found in Applicant's goods would reflect adversely upon and seriously injure the valuable reputation and goodwill of Opposer.

ANSWER: The Applicant denies each and every averment and legal conclusion set forth in paragraph 10.

11. For the foregoing reasons, Opposer would be greatly damaged by the registration of the proposed mark by Applicant.

ANSWER: The Applicant denies each and every averment and legal conclusion set forth in paragraph 11.

FIRST AFFIRMATIVE DEFENSE – NO CAUSE OF ACTION

The Opposer's Notice of Opposition fails to state a claim upon which relief may be granted.

WHEREFORE, Applicant respectfully requests that Application Serial No. 76545073 be allowed to register, and that this Opposition be dismissed in favor of Applicant and that Applicant be granted such further relief as may be just and proper in the premises.

Respectfully submitted

By: 

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CERTIFICATE OF MAILING

Date of Deposit: July 27th, 2005

I hereby certify that a true and correct copy of this Answer to Notice of Opposition regarding Application for "HWA plus Design" (Serial No. 76545073) is being deposited with the United States Postal Services "Express Mail Post Office to Address" under 37 C.F.R. 1.10 on the date indicated above and is addressed to the United States Patent and Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, Virginia 22313-1451 and further certify that this Answer to Notice of Opposition was deposited with the United States Postal Services on the date indicated above and is addressed to James M. Gibson, 30 Rockefeller Plaza, New York, New York 10112-3800.


Kourtney A. Mulcahy
Attorney for Applicant